

1 ROBERT J. YORIO (SBN 93178)  
ryorio@carrferrell.com  
2 V. RANDALL GARD (SBN 151677)  
rgard@carrferrell.com  
3 CHRISTOPHER P. GREWE (SBN 245938)  
cgrewe@carrferrell.com  
4 CARR & FERRELL LLP  
2200 Geng Road  
5 Palo Alto, California 94303  
Telephone: (650) 812-3400  
6 Facsimile: (650) 812-3444

7 *Attorneys for Plaintiff and Counter-Defendant*  
8 MARK L. MCHUGH

9  
10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA  
12 SAN FRANCISCO DIVISION

13 MARK L. MCHUGH, an individual,  
14  
15 Plaintiff and Counter-Defendant,  
16  
17 v.  
18 HILLERICH & BRADSBY CO., a private  
company,  
19  
20 Defendant.

**CASE NO. C 07-03677 JSW**

**PLAINTIFF AND COUNTER-DEFENDANT  
MARK L. MCHUGH'S REPLY AND  
AFFIRMATIVE DEFENSES TO  
HILLERICH & BRADSBY CO.'S  
COUNTERCLAIMS**

**DEMAND FOR JURY TRIAL**

21  
22  
23  
24  
25  
26  
27  
28  
AND RELATED COUNTERCLAIMS.

Plaintiff and Counter-Defendant Mark L. McHugh ("McHugh" or "Plaintiff and Counter-Defendant"), by and through his attorneys of record, hereby reply to the Counterclaims of Defendant and Counterclaimant Hillerich & Bradsby Co. ("H&B" or "Defendant") filed in the above-captioned action.

**ALLEGATIONS REGARDING THE PARTIES**

1. On information and belief, Plaintiff and Counter-Defendant admits that Defendant and Counterclaimant is a Kentucky corporation having a principal place of business at 800 West Main



1 Street, Louisville, Kentucky 40202.

2 2. Plaintiff and Counter-Defendant admits that he is an individual residing in the State of  
3 California.

4 **ALLEGATIONS REGARDING JURISDICTION AND VENUE**

5 3. Plaintiff and Counter-Defendant admits that the Court has jurisdiction over the subject  
6 matter of these Counterclaims pursuant to 28 U.S.C. §§ 1331 and 1338(a).

7 4. Plaintiff and Counter-Defendant admits that this Court has personal jurisdiction over  
8 Plaintiff and Counter-Defendant because he resides in this judicial district. Plaintiff and Counter-  
9 Defendant admits that he has consented to the personal jurisdiction of this Court by bringing this  
10 action.

11 5. Plaintiff and Counter-Defendant admits that venue in this judicial district is proper  
12 under 28 U.S.C. §§ 1391 and 1400. Plaintiff and Counter-Defendant admits that he has consented to  
13 venue in this Court by bringing this action. Plaintiff and Counter-Defendant admits that he is a  
14 resident of California.

15 **FIRST COUNTERCLAIM**

16 **(Declaratory Judgment of Non-Infringement)**

17 6. Plaintiff and Counter-Defendant repeats and realleges his responses to the allegations  
18 in paragraph 1 through 5 of the Counterclaims as though fully set forth herein.

19 7. Plaintiff and Counter-Defendant admits that he is the inventor and owner of U.S.  
20 Patent No. 5,806,091 (the “’091 Patent”), entitled “Hand Grip Aid,” issued by the United States  
21 Patent and Trademark Office on September 15, 1998.

22 8. Plaintiff and Counter-Defendant admits that he filed suit against Defendant and  
23 Counterclaimant in this Court alleging in his Complaint that Defendant and Counterclaimant has  
24 infringed one or more claims of the ‘091 Patent

25 9. Plaintiff and Counter-Defendant admits that Defendant and Counterclaimant seeks a  
26 declaration that it has not and does not directly, indirectly, contributorily and/or by inducement  
27 infringe any valid and enforceable claim of the ‘091 Patent, either literally or under the doctrine of  
28 equivalents, but Plaintiff and Counter-Defendant denies that there is any substantive basis to support



1 Defendant's right to the requested relief.

2 10. Plaintiff and Counter-Defendant admits that an actual and justiciable controversy  
3 exists between Plaintiff and Counter-Defendant and Defendant and Counterclaimant regarding the  
4 infringement of the '091 Patent.

5 **SECOND COUNTERCLAIM**

6 **(Declaratory Judgment of Invalidity and/or Unenforceability)**

7 11. Plaintiff and Counter-Defendant repeats and realleges his responses to the allegations  
8 in paragraph 1 through 10 of the Counterclaims as though fully set forth herein.

9 12. Plaintiff and Counter-Defendant admits that Defendant and Counterclaimant seeks a  
10 declaration that the claims of the '091 Patent are invalid and/or unenforceable for failure to meet the  
11 conditions of patentability as set forth in 28 U.S.C. §§ 101, 102, 103, and/or 112, but Plaintiff and  
12 Counter-Defendant denies that there is any substantive basis to support Defendant's right to the  
13 requested relief.

14 13. Plaintiff and Counter-Defendant admits that an actual and justiciable controversy  
15 exists between Plaintiff and Counter-Defendant and Defendant and Counterclaimant regarding the  
16 alleged invalidity and/or unenforceability of the '091 Patent.

17 14. Plaintiff and Counter-Defendant denies the allegations of paragraph 14.

18 **AFFIRMATIVE DEFENSES TO COUNTERCLAIMS**

19 **FIRST AFFIRMATIVE DEFENSE**

20 Each of the counterclaims fails to state facts sufficient to constitute a cause of action against  
21 Plaintiff and Counter-Defendant McHugh.

22 **SECOND AFFIRMATIVE DEFENSE**

23 Defendant and Counterclaimant has been, and is now, infringing, directly and indirectly by  
24 way of inducement and/or contributory infringement, the claims of the '091 Patent.

25 **THIRD AFFIRMATIVE DEFENSE**

26 Each of the counterclaims fails to state a claim upon which relief may be granted against  
27 Plaintiff and Counter-Defendant McHugh.



**FOURTH AFFIRMATIVE DEFENSE**

Defendant and Counterclaimant is not entitled to recover any attorneys' fees or expenses in this action.

WHEREFORE, Plaintiff and Counter-Defendant prays for relief as set forth below.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff and Counter-Defendant requests entry of judgment in his favor and against Defendant and Counterclaimant as follows:

A. Dismissing all Counterclaims with prejudice;

B. On the First Counterclaim, adjudging that Defendant and Counterclaimant has infringed one or more claims of the '091 Patent and that such infringement has been willful;

C. On the First Counterclaim, preliminarily and/or permanently enjoining Defendant and Counterclaimant and its officers, agents, servants, employees, parents, subsidiaries, affiliate corporation, other related business entities and all other persons acting in concert, participation or in privity with them, and their successors and assigns, from any commercial manufacture, use, offer for sale within the United States or importation into the United States, of any product that infringes the '091 Patent, in accordance with 35 U.S.C. § 283;

D. On the Second Counterclaim, adjudging that the '091 Patent is valid and enforceable;

E. Declaring this an exceptional case and awarding Plaintiff and Counter-Defendant attorneys fees, as provided by 35 U.S.C. § 285; and

F. Awarding Plaintiff and Counter-Defendant such other and further relief as this Court may deem just and proper.

CARR & FERRELL LLP

Dated: November 2, 2007

By: /s/ Christopher P. Grewe  
CHRISTOPHER P. GREWE

*Attorneys for Plaintiff and Counter-Defendant*  
MARK L. MCHUGH



**DEMAND FOR JURY TRIAL**

Plaintiff and Counter-Defendant demands a trial by jury on all issues triable of right by a jury.

CARR & FERRELL LLP

Dated: November 2, 2007

By: /s/ Christopher P. Grewe  
CHRISTOPHER P. GREWE

*Attorneys for Plaintiff and Counter-Defendant*  
MARK L. MCHUGH